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In re Application of	:	DECISION ON
MATSUI	:	
Application No.: 10/561,629	:	PETITION UNDER
PCT No.: PCT/JP2004/008710	:	
Int. Filing Date: 21 June 2004	:	37 CFR § 1.47(b)
Priority Date: 20 June 2003	:	
Attorney Docket No.: 19036/40796	:	
For: OPTHALMIC COMPOSITION	:	

This is a decision on applicant's renewed petition under 37 CFR 1.47(b) and applicant's petition under 37 CFR 1.59(b), both filed in the United States Patent and Trademark Office (USPTO) on 09 October 2007.

BACKGROUND

On 21 June 2004, applicant filed international application PCT/JP2004/008710, which designated the US and claimed a priority date of 20 June 2003. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 29 December 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 20 December 2005.

On 20 December 2005, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 06 July 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventor in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) were required. The NOTIFICATION set a two-month extendable period for reply.

On 07 February 2007, applicant submitted a petition under 37 CFR 1.47(b) and a petition under 37 CFR 1.183. The petitions were accompanied by, *inter alia*, a petition/fee for a five month extension of time, the surcharge under 37 CFR 1.492(h), a declaration of facts by Madoka Yamashita, and a memorandum of law by Tadato Fujiwara.

On 16 March 2007, applicant submitted a petition under 37 CFR 1.182.

On 11 June 2007, a decision was mailed dismissing without prejudice applicant's petition under 37 CFR 1.47(b), applicant's petition under 37 CFR 1.183, and applicant's petition under 37 CFR 1.182.

On 09 October 2007, applicants filed the instant renewed petition under 37 CFR 1.47(b) and the petition under 37 CFR 1.59(b). The petition under 37 CFR 1.47(b) was accompanied by, *inter alia*, a declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, a statement of facts by Naoka Harada, a statement of facts by Yasuyo Yamaguchi, a statement of facts by Naonori Murakami, an English translation of the priority document for the instant application—Japanese Application No. 2003-176965, a chart showing support in the English translation of the priority document for the claims in the instant application, a copy of an oath signed by nonsigning inventor Yuka Matsui dated 16 April 2001 and an English translation thereof, and a copy of “Regulations for Employee’s Invention” and an English translation thereof.

DISCUSSION

Petition Under 37 CFR 1.47(b)

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

As noted in the decision mailed 09 October 2007, items (1) and (6) have been met.

Items (2), (3), and (4) have now been met as well.

Item (5) has not been met. The chart showing support in the English translation of the priority document for the claims in the instant application has been considered. However, even assuming *arguendo* that the claims have support in the priority application, it is not clear that there is no matter in the international application which is not in the priority application. Such matter could be added to the claims by amendment at a later date. The statement of facts by Naonori Murakami and the “Regulations for Employee’s Invention” have also been considered. If petitioner is attempting to show that this agreement was an employment agreement where inventor Matsui as an employee agreed to assign all inventions made during her employment to her employer, a statement of a person having firsthand knowledge of the facts that the invention

was made by the employee while employed by Kobayashi Pharmaceuticals Co., Ltd. must be provided. Attention is directed to MPEP § 409.03 which states in part:

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

Petition Under 37 CFR 1.59(b)

Petitioner requests that the documents submitted as exhibits with the initial petition filed 07 February 2007 be expunged from the record. Petitioner has provided redacted copies of these exhibits (Exhibits A-F filed 09 October 2007). Petitioner states that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant application.

Applicant is required to retain the expunged material(s) for the life of any patent which issues on the above-identified application.

The expunged material has been removed from the official file.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

For the reasons set forth above, the petition under 37 CFR 1.59(b) is **GRANTED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

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